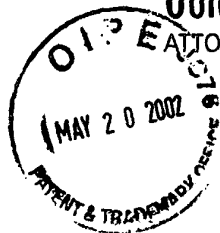




**Sterne Kessler
Goldstein Fox**

ATTORNEYS AT LAW



112, 2nd - 9-

Robert Greene Sterne
Edward J. Kessler
Jorge A. Goldstein
David K.S. Cornwell
Robert W. Esmond
Tracy-Gene G. Durkin
Michele A. Cimbala
Michael B. Ray
Robert E. Sokohl
Eric K. Steffe
Michael Q. Lee
Steven R. Ludwig
John M. Covert
Linda E. Alcorn
Robert C. Millonig
Lawrence B. Bugalsky
Donald J. Featherstone
Michael V. Messinger
Judith U. Kim
Timothy J. Shea, Jr.

Patrick E. Garrett
Jeffery T. Helvey*
Heidi L. Kraus
Crystal D. Sayles
Edward W. Yee
Albert L. Ferro*
Donald R. Banowitz
Peter A. Jackman
Molly A. McCall
Teresa U. Medler
Jeffrey S. Weaver
Kendrick P. Patterson
Vincent L. Capuano
Albert J. Fasulo II*
Eldora Ellison Floyd
W. Russell Swindell
Thomas C. Fiala
Brian J. Del Buono*
Virgil Lee Beaton*
Reginald D. Lucas*

Kimberly N. Reddick
Theodore A. Wood
Elizabeth J. Haanes
Bruce E. Chalke
Joseph S. Ostroff
Frank R. Cottingham*
Christine M. Uhler
Rae Lynn Prengaman*
Jane Shershenovich*
Lawrence J. Carroll*
George S. Bardmesser

Senior Counsel
Samuel L. Fox
Kenneth C. Bass III

Registered Patent Agents
Karen R. Markowicz
Andrea J. Kamage

Nancy J. Leith
Joseph M. Conrad III
Ann E. Summerfield
Helene C. Carlson
Gaby L. Longworth
Matthew J. Dowd
Aaron L. Schwartz
Angelique G. Uy
Boris A. Matvenko
Mary B. Tung
Katrina Y. Pei
Bryan L. Skelton
Jason D. Eisenberg

*Admitted only in Maryland
*Admitted only in Virginia
*Admitted only in Texas

May 20, 2002

WRITER'S DIRECT NUMBER:
(202) 371-2560
INTERNET ADDRESS:
RESMOND@SKGF.COM

RECEIVED

MAY 22 2002

Art Unit 1651

Commissioner for Patents
Washington, D.C. 20231

TECH CENTER 1600/2900

Re: U.S. Utility Patent Application
Appl. No. 09/028,514; Filed: February 23, 1998
For: **Serum-Free Mammalian Cell Culture Medium, and Uses Thereof**
Inventors: Gorfien, *et al.*
Our Ref: 0942.4110002/RWE/B-C

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Restriction Requirement; and
2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

1-14
1599
15-37
add
73-77

1-3
6-17
20-24
27-37
73-77
140
154
157-174

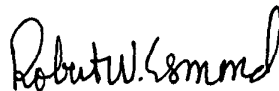
1-3, 6-17, 20-24, 27-37,
73-82, 106-108, 112, 110

Commissioner for Patents
May 20, 2002
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

RWE/B-C:law
Enclosures

SKGF_DC1:15230.1



#28
JMS
5/28/02

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Gorfien, *et al.*

Appl. No. 09/028,514

Filed: February 23, 1998

For: **Serum-Free Mammalian Cell
Culture Medium, and Uses Thereof**

Confirmation No. 4800

Art Unit: 1651

Examiner: Ware, Deborah K.

Atty. Docket: 0942.4110002/RWE/B-C

RECEIVED

MAY 22 2002

TECH CENTER 1600/2900

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **April 23, 2002**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicant hereby provisionally elects to prosecute the invention of Group I, represented by claims 1-3, 6-17, 20-24, 27-37, 73-77, 140, 154, and 157-174. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

Applicants wish to clarify a point prior to presenting their reasons for traversal. The mammalian cells in the methods of independent claims 1, 15, 22, 157, 158, and 161 may be either recombinant or non-recombinant. Applicants also wish to point out that independent claim 106 also encompasses cultivating both a recombinant and a non-recombinant mammalian cell. Thus, the methods of Group I are not limited to non-recombinant cells and the methods of Group II are not limited to recombinant cells.

The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803.

Applicants respectfully assert that the claims in Groups I and II are closely related in subject matter. In fact, a search for methods of cultivating mammalian cells—claims 1, 15, 22, 158 and claims dependent thereon—must *necessarily* encompass a search for methods of cultivation of mammalian cells that are genetically engineered and used for protein expression—see, for example, claims 79, 106 and claims dependent thereon—because, as discussed above, the invention of Group I is not limited to non-recombinant cells. Applicants note that claim 79 depends from claims 1, 5, and 22 and a search for the inventions of these claims must encompass the invention of claim 79.

Moreover, the Examiner has not satisfied the second requirement set forth in MPEP § 803, *i.e.* the Examiner has not shown why a serious burden would be imposed on the Examiner if restriction were not required. It should be noted that the two requirements set forth in MPEP § 803 are connected with "and." Hence, satisfaction of both is required. The Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been established, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Applicants respectfully submit that a search of Group I is likely to encompass subject matter pertinent to the patentability Group II and, therefore, searching both Groups does not represent a serious burden on the Examiner. Hence, reconsideration and withdrawal of the

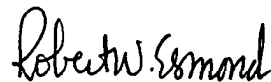
Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

Should the Examiner maintain the Restriction Requirement and search only Group I, Applicants respectfully request that the Examiner consider rejoinder of Group II if the search performed encompasses the inventions of the restricted claims.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

Date: May 20, 2002

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600